



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,084	04/06/2000	Asgeir Saebo	CONLINCO-04286	7973

7590

12/28/2001

J Mitchell Jones  
Medlen & Carroll LLP  
220 Montgomery Street  
Suite 2200  
San Francisco, CA 94104

EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/544,084

Applicant(s)

SAEBO ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 1617

### **DETAILED ACTION**

1. The Request for a Continued Prosecution Application (RCE) filed on October 18, 2001 under 37 CFR 1.114 based on parent Application No. 09544084 is acceptable and a RCE has been established. An action on the RCE follows.

2. Receipt of applicants' amendments and remarks submitted October 18, 2001 is acknowledged.

### ***Double Patenting Rejections***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-16 of U.S. Patent No. 6,015,833 in view of Cook et al. (U.S. 5,760,082). Patent '833 claim food product containing conjugated linoleic acid. The Patent does not claim food product contains the derivatives of conjugated linoleic acid, e.g., ester, or the employment of alcohols or vitamin E in the food products. However, Cook teach that the derivative of conjugated linoleic acid, including esters, are similarly useful as the free acid in food products. See, column2, lines 62-67. It is well known that alcohols or vitamin E are frequently added to food products. Therefore, it would have been obvious for an ordinary skill in

Art Unit: 1617

the art at the time the claimed invention was made to making food product containing conjugated linoleic acid derivatives, including ester, alcohols or vitamin E.

3. Please note a terminal disclaimer has not been received by the office.

***Claim Rejections 35 U.S.C. §103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (U.S. Patent 5,760,082 of record) in view of Cain et al. (WO 97/18320, IDS 35) and Baltes et al. (U.S. Patent 3,162,658, of record), and in further view of Nilsen et al. (U.S. Patent 5,885,594, IDS 26).

6. Cook teaches a food product containing conjugated linoleic acids, their esters, salts or mixtures. The linoleic acid compounds may be from corn oil, safflower etc. the food products may further containing vitamins. The conjugated linoleic acid may be in the forms of free acid, non toxic salt or esters, such as triglycerides. See, particularly, the abstract, column 1, lines 10-13, lines 49-60. Column 2, lines 51-67, Examples 2- 5. Cook teaches that employment of alkali catalyst for making conjugated linoleic acid moiety for linoleic acid moiety is known. See, particularly, example 1, in column 2. Cook further teaches that conjugated linoleic acid may be incorporated into various food products. See column 5, lines 6-14.

Art Unit: 1617

7. Cook does not teach expressly to employ antioxidants such as vitamin E or alcohols in the food products or the conjugated linoleic acid compounds are produced by the method herein, e.g., treating linoleic acid with potassium methyllate.

8. However, Cain et al. teaches that it is well-known in the art that antioxidants, such as vitamin E or BHT, is known to be useful in food product containing conjugated linoleic acid compounds, e.g., conjugated linoleic acid ester. See, particularly, page 6, lines 29-36, the examples 1-20 and the claims. Baltes teach that isomerization of linoleic acid compounds to conjugated linoleic acid compounds by alcoholate catalysts, such as potassium methyllate is well known. See, particularly, the examples 2-4 and the claims. The employment of alkali monohydric alcoholate has advantage that isomerization is possible without using more than stoimetical amounts of alkali metal alcoholate. See column 2, lines 31-35.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidant in a food product.

A person of ordinary skill in the art would have been motivated to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidants in a food product because antioxidant are known to be useful along with conjugated linoleic acid compounds in food products. Further, alcoholic products, such as wine, are well known to be frequently added to food products. The employment of alcohol herein is seen to employment of a known food ingredient to a food product and therefore is obvious. Claims 25 and 26 are obvious for reasons sated above and in further view of Nilsen et al. Nilsen et al. teaches that conjugated linoleic acid are known to be useful in alcoholic products, such as wine or beer. See, particularly, the abstract,

Art Unit: 1617

column 7, line 59 bridging column 8, line 4. Regarding the limitation about the method to obtain the conjugated linoleic acid, note a method of making ingredients is not seen to render patentable weight to a method which employs such ingredients, absent evidence to the contrary. It is particularly true if the method of making the ingredients is a well-known process, e.g., employ alkali monohydric alcoholate for making conjugated linoleic acid. A process of making a composition by simply combining or mixing the known ingredients is seen to be within the skill of the artisan.

### **Response to the Arguments**

Applicants' amendments and remarks, and the declaration of Dr. Asgeir Sæbo submitted October 18, 2001 have been fully considered, but are not persuasive for reasons discussed below.

9. The declaration filed October 18, 2001 is insufficient to overcome the rejection of claims 1-30 set forth above because: the teaching of Baltes et al. is not limited to the particular oil disclosed in the examples therein. Baltes teaches a general method for isomerising unconjugated polyethenoid to conjugated polyethenoid. See, column 1, lines 13-16. The starting material may be any unconjugated polyethenoid compounds or products containing them. See column 8, lines 20-68. Further, applicant appears to argue the employment of the reaction mixture to foodstuff, what is actually in the claims are the compounds, i.e., conjugated linoleic esters. ("to provide conjugated linoleic acid esters", see the claims in instant application).

10. The double patenting rejection is maintained because a terminal disclaimer has not been received.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

Art Unit: 1617

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestions or motivation are found in both the references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Cook teaches the usefulness of CLA in food products wherein the food product may contain vitamins, ethanol is a well-known ingredient in food product, it is therefore obvious to blend CLA in food products including those containing ethanol or vitamin E. The technique involved herein may not be such sophisticated that one of ordinary skill in the art would have seen it to be obvious to employ CLA in any food product.

12. Regarding the remarks about the teachings of Baltes, see the discussion about Dr. Asgeir Sæbo's declaration above. Further, applicants should not confuse compounds ("conjugated linoleic acid esters" in the claims) with composition containing the compounds. A compound would be the same regardless of methods of making it.

13. Regarding applicants' remarks that references do not teach all of the elements of the claims, note the examiner presents the fact "alcohol is a well-known food ingredient" which applicants have not rebutted. Further, no evidence showing the employment of alcohol would give unexpected or unobvious results.

14. Applicants assert that the cited references do not provide a reasonable expectation of success. Particularly, applicants assert that one skilled in the art would not believe that a reasonable expectation of success existed for arriving at utilizing alcoholate catalysts to produce

Art Unit: 1617

CLA. As discussed above, Baltes shows that alcoholate catalysts are useful for making CLA. Applicants' conclusion that "Baltes is directed to solely to the production of conjugated fatty acids for technical uses such as in vanishing and lacquers" is incorrect. As discussed above, Baltes teaches a general method for isomerising unconjugated polyethenoid to conjugated polyethenoid. See, column 1, lines 13-16. The starting material may be any unconjugated polyethenoid compounds or products containing them.

15. Nothing unobvious in the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

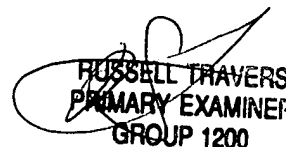
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Shengjun Wang

AU 1617

December 21, 2001



RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200